

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
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Radhika AGGARWAL, et al.	:	Confirmation Number: 2419
	:	
Application No.: 10/041,141	:	Group Art Unit: 2178
	:	
Filed: January 3, 2002	:	Examiner: T. Huynh
	:	
For: INLINE ERROR HIGHLIGHTING	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated May 11, 2010.

The Examiner's response to Appellants' arguments submitted in the Fourth Appeal Brief of February 23, 2010 (hereinafter the Fourth Appeal Brief), raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Fourth Appeal Brief and the arguments set forth below.

REMARKS

Appellants have compared the statement of the rejection found on pages 3-10 of the Examiner's Answer with the statement of the rejection found on pages 2-8 of the Ninth Office Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to the Fourth Appeal Brief is found on pages 10-13 of the Examiner's Answer.

Actual Reduction to Practice

The Examiner's response to Appellants' arguments is found in the penultimate paragraph on page 10 of the Examiner's Answer, and is reproduced below:

Examiner respectfully disagrees. As explained in the Office Actions dated 5/6/2005 and specially 09/2/2005 (Response Argument, page 7), that, the written description and an illustrated test result on page 2 of Exhibit A can not qualify a reduction to practice, since they are not test results that actually run/occur successful from an apparatus. It is noted that the illustrated test result on page 2 of Exhibit A is not a screen shot(s) which was tested from a system or apparatus. Simply providing conception of the claim invention (Declaration provide "a disclosure document" which "describing an embodiment of the Invention") and illustration/presentation how the conception works (Declaration demonstrates of error message displayed in a row below a user input field) do not indicate that test results actually existed/occur and was successful. Therefore, the Declarations filed on 12/21/2004 and 12/05/2005 are insufficient to establish a reduction to practice. (emphasis added)

Decisions of the Patent Office are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. '706, to appeals of PTO rulings). Thus the Patent Office's factual findings are reviewed to determine whether they are unsupported by substantial evidence. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000). Substantial evidence means

1 "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept
2 as adequate to support a conclusion." Richardson v. Perales, 402 U.S. 389, 401 (1971).

3
4 Referring to the underlined portion of the above-reproduced passage, the Examiner made
5 the factual finding that the "test result on page 2 of Exhibit A is not a screen shot(s) which was
6 tested from a system or apparatus." This finding, however, is not supported by substantial
7 evidence. In fact, the Examiner has produced no evidence (or even explanation) to support the
8 Examiner's finding. Thus, the Examiner's finding is not supported by even a scintilla of evidence
9 and cannot be considered to be supported by substantial evidence. Thus, the Examiner's finding
10 cannot be relied upon.

11
12 Notwithstanding that the Examiner's finding cannot be relied upon, the Examiner did not
13 even present an analysis to support the Examiner's allegations. The claimed invention is directed
14 to a method ultimately associated with a graphical user interface. Although claim 1 does not
15 claim displaying "the markup specified form," when the markup specified form (which is created
16 as part of the methodology of claim 1) is displayed as part of a graphical user interface, certain
17 claimed characteristics would be evident. As discussed on pages 5 and 6 of the Fourth Appeal
18 Brief, these claimed characteristics are illustrated in Exhibit A from the First Declaration, which
19 is reproduced on page 5 of the Fourth Appeal Brief. Appellants' position is that a successful "test
20 result" of the claimed invention would produce a result identical to that shown in Exhibit A.¹
21 Moreover, the Examiner has not even attempted to explain why Exhibit A "is not a screen shot(s)
22 which was tested from a system or apparatus." For example, the Examiner could have attempted

¹ Bearing in mind that although differing results could be generated depending upon factors not claimed, such as the verbiage used, fonts, certain placement of features, etc.

1 to explain why a successful test result of the claimed invention would look differently than that
2 presented in Exhibit A. However, the Examiner eschewed this approach and, instead, presented
3 a conclusory finding not supported by substantial evidence.
4

5 Standing in stark contrast to the Examiner's factually-unsupported conclusory findings,
6 Appellants submitted a properly-executed Declaration indicating that Appellants had created an
7 experimental prototype of the claimed invention and generated a Disclosure Document (prior to
8 the filing date of Upton), in which was included a successful test result (i.e., now referred to as
9 Exhibit A). Thus, whereas Appellants have submitted substantial evidence to support their
10 position, the Examiner has failed to provide substantial evidence to support the Examiner's
11 opposite position. Therefore, the Examiner has committed reversible error in holding that the
12 Declaration is insufficient to establish actual reduction to practice.
13

14 The Examiner did not identify any other deficiency in the evidence presented by
15 Appellants to establish actual reduction to practice. Thus, since the Examiner's only finding as to
16 the deficiency of the Declaration is itself unsupported by substantial evidence, the Examiner has
17 failed to establish that Appellants' Declaration is insufficient. Therefore, Appellants have
18 submitted sufficient evidence to establish actual reduction to practice of the claimed invention
19 prior to the filing date of Upton.
20

21 Constructive Reduction to Practice

22 The Examiner's "response" on pages 11-12 of the Examiner's Answer is nearly identical
23 to the Examiner's initial response to the Second Declaration, which is found on page 8 of the

Fourth Office Action dated February 24, 2006. Notably, what the Examiner fails to provide is any explanation as to how to cure the alleged defects in the Declarations or what would be sufficient explanation to account for the identified periods.

Res Judicata

In the last full paragraph on page 12 of the Examiner's Answer, the Examiner asserted the following:

Examiner respectfully disagrees. All prosecutions and evidences in the file wrapper of this application, including the Declarations filed on 12/21/04 and 12/05/05 which filed before Board Decision dated 09/29/2007 are presented to Board. Although Board does not specifically mention about the Declarations, however, these Declarations are insufficient as explained in the response to argument above. (emphasis in original)

At the outset, Appellants are unclear as to exactly what the Examiner means when the Examiner asserts that the evidence was "presented to the Board" (emphasis in original). The alleged fact that the file wrapper of the application was "presented" to the Honorable Board does not establish that (i) the Declarations were entered or (ii) the Declarations and the Examiner's findings with regard to these Declarations were reviewed by the Honorable Board. As noted in the paragraph spanning pages 14-15 of the Fourth Appeal Brief, Appellants did not have these Declarations entered as part of the First Appeal Brief. Also, neither the Examiner (in the First Examiner's Answer), nor Appellants (in the First Appeal Brief and Reply Brief), nor the Honorable Board in its Decision on Appeal addressed the Declarations or the findings made by the Examiner regarding these Declarations.

Referring to See Ex parte Frye, Appeal No. 2009-006013 (precedential), the Honorable Board clearly enunciated that "[o]ur decision is limited to the finding before us for review" (emphasis added). The Honorable Board further stated:

Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue – or, more broadly, on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. See, e.g., Hyatt v. Dudas, 551 F.3d 1307, 1313-14 (Fed. Cir. 2008) (the Board may treat arguments appellant failed to make for a given ground of rejection as waived); In re Watts, 354 F.3d 1362, 1368 (Fed. Cir. 2004) (declining to consider the appellant's new argument regarding the scope of a prior art patent when that argument was not raised before the Board); In re Schreiber, 128 F.3d 1473, 1479 (Fed. Cir. 1997) (declining to consider whether prior art cited in an obviousness rejection was non-analogous art when that argument was not raised before the Board). Thus, the Board will generally not reach the merits of any issues not contested by an appellant. Cf. In re Baxter Travenol Labs, 952 F.2d 388, 391 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant ..."). For example, if an appellant contests an obviousness rejection only on the basis that a cited reference fails to disclose a particular limitation, the Board need not review the other, uncontested findings of fact made by the examiner underlying the rejection, such as the presence of uncontested limitations in the prior art.

As evidenced by the discussion above, arguments and evidence that were not presented by appellant during appeal will, in most instances, not be reviewed by the Honorable Board.

In the first appeal, neither the Examiner nor Appellants raised, as an issue for review, the findings of the Examiner with regard to the Declarations. Thus, with regard to the first appeal, the Honorable Board did not review these findings or the Declarations when rendering the Decision on Appeal. Since the Declarations and the findings made by the Examiner were not reviewed by the Honorable Board, the Declarations are considered "new evidence," as that term is used in the case law discussed on pages 15 and 16 of the Fourth Appeal Brief. Therefore, the Examiner's application of *res judicata* is inappropriate in the present application.

For the reasons set forth in the Fourth Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: July 12, 2010

Respectfully submitted,

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CUSTOMER NUMBER 46320